



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/565,884

01/25/2006

Seiichi Itoda

32178-227629

8077

26694

7590

12/23/2009

VENABLE LLP

P.O. BOX 34385

WASHINGTON, DC 20043-9998

EXAMINER

SHOLEMAN, ABU S

ART UNIT

PAPER NUMBER

2437

MAIL DATE

DELIVERY MODE

12/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/565,884	ITODA, SEIICHI	
	Examiner	Art Unit	
	ABU SHOLEMAN	2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/27/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2009 has been entered.

2. Claims 1, 5 and 9-11 are pending in the present application. Claims 1 and 5 are amended. Claims 2-4 and 6-8 are canceled.

Response to Amendment

3. Applicant's arguments, see pages 1-4, filed 10/27/2009, with respect to the rejection(s) of claim(s) 1,5 and 9-11 under 35 U.S.C § 103(a), have been fully considered but are moot in view of the new ground(s) of rejection .

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2437

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chainer et al (US 6957337) (hereinafter Chainer) in view of Murase et al (US 2002/0046347) (hereinafter Murase) and further in view of Hideaki et al (JP 2003044892) (hereinafter Hideaki).

As per claim 1, Chanier discloses "a multi-authenticating method also for use in organism authentication, comprising the steps of:

"making the organism authentication by using a physical feature of an authentication target and, when a result of said organism authentication indicates an affirmative(column 2, lines 59-63, and Fig.3, authenticating a subject includes using one of a plurality of biometric measurements which is captured and stored in secured card), thereafter issuing an authenticating medium by which simple and prompt authentication can be made on the assumption that the affirmative result of the organism authentication is obtained wherein said authenticating medium is a personal property of the user of the organism authentication and used as an authentication target (column 6, lines 47-67, and Fig.3, numeral 301 capture and transmit biometric data to the processor 120 and numeral 302, compare biometric data and numeral 303 match found then provide identity device at numeral 308, column 5, lines 40-60, and Fig .2, the card is provided to the owner with a password [authentication data of biometric] which is known to the authentication system);

authenticating the authentication target by using said authenticating medium and permitting use of another apparatus in accordance with a result of the authentication by

Art Unit: 2437

said authenticating medium (column 7, lines 55-64, device or card [authenticating medium] of biometric [authentication target] is authorized by remote server to use a machine [another apparatus] and column 2, lines 59-63, authenticating a subject includes using one of a plurality of biometric measurements which is captured and stored in secured card).

But Chanier fails to disclose “storing, in a registrant database, authenticating medium validity term data and at least one use authority datum corresponding to a unique registrant identifier;

searching the registrant database, using a registrant database searching unit, for the authenticating medium validity term data and the at least one use authority datum based on the unique registrant identifier read from the personal property;

discriminating whether or not the use of an authenticating personal property apparatus is permitted, using a discriminating unit, on the basis of the authenticating medium validity term data and the at least one use authority datum based on the unique registrant identifier read from the personal property, wherein if the use of the authenticating personal property apparatus is permitted the personal property is collected by a card collecting unit as said authenticating medium and if the authenticating personal property apparatus is not permitted to be used, the card collecting unit returns the personal property to the user”.

However, Murase discloses " storing, in a registrant database, authenticating medium validity term data and at least on use authority datum corresponding to a unique registrant identifier (par 0090, and Fig.9, numeral 9 database of Ticket ID [unique registrant identifier] and Available data and time [validity term data] and a ticket can be used, use conditions such as an available facility [use authority datum]);

searching the registrant database, using a registrant database searching unit, for the authenticating medium validity term data and the at least one use authority datum based on the unique registrant identifier read from the personal property (par 0085-0086, and Fig. 9, the user status of a user or ticket can be grasped by searching for user status data and/ or biological information data on the network server [database]);

discriminating whether or not the use of an authenticating personal property apparatus is permitted, using a discriminating unit, on the basis of the authenticating medium validity term data and the at least one use authority datum based on the unique registrant identifier read from the personal property (par 0086, disposing [discriminating] the ticket [personal property] based on the authentication of available data and time [validity term data] and a ticket can be used , use conditions such as an available facility [use authority datum]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to implement the claimed invention by modifying the method of Chanier, based on the teachings of Murase, because doing so, would improve the authentication of user biometric information of the personal property.

The combination of Chanier and Murase fail to disclose "wherein if the use of the authenticating personal property apparatus is permitted the personal property is collected by a card collecting unit as said authenticating medium and if the authenticating personal property apparatus is not permitted to be used, the card collecting unit returns the personal property to the user".

However, Hideaki discloses "where if the use of the authenticating personal property apparatus is permitted the personal property is collected by a card collecting unit as said authenticating medium and if the authenticating personal property apparatus is not permitted to be used, the card collecting unit returns the personal property to the user (Hideaki, par [0092], personal digital assistant 100A with fingerprint that is transmitted to the management equipment 10 [card collecting unit] for matching that fingerprint in the management tools for visitors. par [0014], the management equipment 10 discernment the card [personal property] if the fingerprint does not match and it can automate [return] to a visitor and the work which publishes discernment material can be quickly done on him [return the card on user]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to implement the claimed invention by modifying the method of Chanier in view of Murase, based on the teachings of Hideaki, because doing so, would improve the use of personal property.

As per claim 5, this claim is directed to a system and contains limitations that are substantially similar to those recited in claim 1 above, and accordingly is rejected for similar reasons.

As per claim 10, Chanier in view of Murase in view of Hideaki disclose Wherein the organism authentication is accompanied in the step of collecting the personal property as said authenticating medium as (Hideaki, par [0092], personal digital assistant 100A with fingerprint that is transmitted to the management equipment 10 [card collecting unit] for matching that fingerprint in the management tools for visitors. par [0014], the management equipment 10 discernment the card [personal property] if the fingerprint does not match and it can automate [return] to a visitor and the work which publishes discernment material can be quickly done on him [return the card on user]).

As per claim 9, Chanier in view of Murase in view of Hideaki “wherein said first authenticating apparatus writes all data necessary for subsequent authentication into

Art Unit: 2437

the personal property of the user of the first authenticating apparatus (Chainer, column 6, lines 47-67, and Fig.3, numeral 301 capture [first apparatus] and transmits [writing] biometric data to the identity device at numeral 308 [personal property of user]), and said second authenticating apparatus can solely discriminate whether or not the use of the another apparatus is permitted on the basis of the data obtained from said personal property” (Chainer, column 6, lines 20-25, a authentication server [second authentication apparatus] can authenticate the device [personal property] wherein all biometric information stored).

.
As per claim 11, Chainer in view of Murase in view of Hideaki “wherein the organism authenticating unit which makes the organism authentication at the time of the collection of said personal property is provided in a recognizing apparatus having the collecting unit which collects the personal property as said authenticating medium as (Chainer, column 9, lines 53-55, card used for instance to gain access to the machines such as ATM-machines, ATM machine collect the card and verify that card based on stored biometric information.) .

Examiner Notes

6. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is

Art Unit: 2437

respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

7. The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See MPEP 707.05(c).

8. The following reference teaches execution of trial data.

US 6970846

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abu Sholeman whose telephone number is (571)270-7314 and Fax number is (571)-270-8314. The examiner can normally be reached on Monday through Friday 9:30 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ABU SHOLEMAN/
Examiner, Art Unit 2437

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437